

Serial No.: 09/918,689

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REMARKS

This is a full and timely response to the outstanding final Office Action mailed September 22, 2005. Reconsideration and allowance of the application and presently pending claims 1-10 and 12-20 are respectfully requested.

1. Response to Rejection of Claims 1-20 Under 35 U.S.C. §103

In the Office Action, claims 1, 3-5, 7, 10, 11, and 14-18 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Berg* (U.S. Patent No. 6,362,897) in view of *Gerbaulet* (U.S. Patent No. 5,544,040). Claims 6 and 15 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Berg* in view of *Gerbaulet* in further view of *Mansutti* (U.S. Patent Application Publication No. 2002/0046195). Claims 8, 9, 12, 13, 19, and 20 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Berg* in view of *Gerbaulet* in further view of *Smith* (U.S. Patent No. 5,995,942).

It is well-established at law that, for a proper rejection of a claim under 35 U.S.C. §103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly or explicitly, all elements/features/steps of the claim at issue. *See, e.g., In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

a. Claim 1

Applicant respectfully submits that claim 1 is allowable for at least the reason that the proposed combination of *Berg* in view of *Gerbaulet* does not disclose, teach, or suggest at least "wherein dimensions of the unitary business machine conform with approximate dimensions of a printed hard copy of one of said forms," as recited in claim 1.

As noted in the Office Action, at page 3, *Berg* does not disclose, teach, or suggest "a hard copy printer in said unitary business machine . . . for printing of hard copy of said forms as selected." Thus, *Berg* fails to disclose, teach, or suggest every element of the Applicant's claimed invention. *Gerbaulet* also fails to disclose, teach, or suggest at least the claimed limitations "wherein dimensions of the unitary business machine conform with approximate dimensions of a printed hard copy of one of said

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forms," since *Gerbaulet* discloses a device that has a width that is approximately 5 times the width of the printed paper being deposited by the device. See Fig. 3.

Accordingly, since both *Berg* and *Gerbaulet* fail to disclose the above recited features of claim 1, the proposed combination of *Berg* in view of *Gerbaulet* does not teach at least the above-recited feature of claim 1. Therefore, a *prima facie* case establishing an obviousness rejection by *Berg* in view of *Gerbaulet* has not been made. Thus, claim 1 is not obvious under proposed combination and the rejection should be withdrawn.

b. Claims 3-9

With respect to claims 3-9, because independent claim 1 is allowable over the cited art of record, dependent claims 3-9 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 3-9 contain all features/elements of independent claim 1 and the references of *Mansutti* and/or *Smith* do not remedy all of the deficiencies of the *Berg* and *Gerbaulet* references. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, the rejection to these claims should be withdrawn.

Additionally and notwithstanding the foregoing reasons for allowability of claims 3-9, these claims recite further features and/or combinations of features (as is apparent by examination of the claims themselves) that are patentably distinct from the cited art of record. Hence, there are other reasons why these dependent claims are allowable. For example, claim 3 includes the feature where "hard copies of stored forms having a pre-arranged format with instructions for supplying information within blank spaces provided on the hard copies of the forms," which is distinct from the construct of the term "form" used in the Office Action where the "Examiner interprets forms to be any form of media having some specified information on it."

For at least these reasons, the rejections should be withdrawn.

c. Claim 10

Applicant respectfully submits that claim 10 is allowable for at least the reason that the proposed combination of *Berg* in view of *Gerbaulet* does not disclose, teach, or suggest at least "wherein the unitary box is conformed in size to approximately match

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the length and width of a sheet of letter sized or legal sized paper," as recited in claim 10.

As noted in the Office Action, at page 3, *Berg* does not disclose, teach, or suggest "a hard copy printer in said unitary business machine . . . for printing of hard copy of said forms as selected." Thus, *Berg* fails to disclose, teach, or suggest every element of the Applicant's claimed invention. *Gerbaulet* also fails to disclose, teach, or suggest at least the claimed limitations "wherein the unitary box is conformed in size to approximately match the length and width of a sheet of letter sized or legal sized paper," since *Gerbaulet* discloses a device that has a width that is approximately 5 times the width of the printed paper being deposited by the device. See Fig. 3.

On this matter, the Office Action alleges that the size of the box is a matter of design choice: "Size of the box can be adapted to fit a particular need based on customer interaction, space availability, cost, etc. Therefore it would have been obvious to make the box approximately the size of a letter or legal pad to keep it small enough to fit in small places." Office Action, page 5. In contrast, while *Gerbaulet* discloses a device that may be comparable in size to a device with features representative of claim 10, *Gerbaulet* still teaches a device with a width that is approximately 5 times the width of the printed paper being deposited by the device. See Fig. 3.

Accordingly, since both *Berg* and *Gerbaulet* fail to disclose the above recited features of claim 10, the proposed combination of *Berg* in view of *Gerbaulet* does not teach at least the above-recited feature of claim 10. Therefore, a *prima facie* case establishing an obviousness rejection by *Berg* in view of *Gerbaulet* has not been made. Thus, claim 10 is not obvious under proposed combination and the rejection should be withdrawn.

d. Claims 11-16

With respect to claims 12-16, because independent claim 10 is allowable over the cited art of record, dependent claims 12-16 (which depend from independent claim 10) are allowable as a matter of law for at least the reason that dependent claims 12-16 contain all features/elements of independent claim 10 and the references of *Mansutti* and/or *Smith* do not remedy all of the deficiencies of the *Berg* and *Gerbaulet* references. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, the rejection to these claims should be withdrawn.

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Additionally and notwithstanding the foregoing reasons for allowability of claims 12-16, these claims recite further features and/or combinations of features (as is apparent by examination of the claims themselves) that are patentably distinct from the cited art of record. Hence, there are other reasons why these dependent claims are allowable. For example, claim 16 includes the feature where "hard copies of stored forms having a pre-arranged format with instructions for supplying information within blank spaces provided on the hard copies of the forms," which is distinct from the construct of the term "form" used in the Office Action where the "Examiner interprets forms to be any form of media having some specified information on it."

For at least these reasons, the rejections should be withdrawn.

Further, claim 11 is canceled without prejudice, waiver, or disclaimer, and therefore, the rejection to the claim is rendered moot. Applicant takes this action merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicant reserves the right to pursue the subject matter of the canceled claim in a continuing application, if Applicant so chooses, and does not intend to dedicate any of the canceled subject matter to the public.

e. Claim 17

Applicant respectfully submits that claim 17 is allowable for at least the reason that the proposed combination of *Berg* in view of *Gerbaulet* does not disclose, teach, or suggest at least "wherein the box is the approximate size of a length and width of a sheet of paper that is used in printing the form," as recited in claim 17.

As noted in the Office Action, at page 3, *Berg* does not disclose, teach, or suggest "a hard copy printer in said unitary business machine . . . for printing of hard copy of said forms as selected." Thus, *Berg* fails to disclose, teach, or suggest every element of the Applicant's claimed invention. *Gerbaulet* also fails to disclose, teach, or suggest at least the claimed limitations "wherein the unitary box is conformed in size to approximately match the length and width of a sheet of letter sized or legal sized paper," since *Gerbaulet* discloses a device that has a width that is approximately 5 times the width of the printed paper being deposited by the device. See Fig. 3.

On this matter, the Office Action alleges that the size of the box is a matter of design choice: "Size of the box can be adapted to fit a particular need based on customer interaction, space availability, cost, etc. Therefore it would have been obvious

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to make the box approximately the size of a letter or legal pad to keep it small enough to fit in small places." Office Action, page 5. In contrast, while *Gerbaulet* discloses a device that may be comparable in size to a device with features representative of claim 10, *Gerbaulet* still teaches a device with a width that is approximately 5 times the width of the printed paper being deposited by the device. See Fig. 3.

Accordingly, since both *Berg* and *Gerbaulet* fail to disclose the above recited features of claim 17, the proposed combination of *Berg* in view of *Gerbaulet* does not teach at least the above-recited feature of claim 17. Therefore, a *prima facie* case establishing an obviousness rejection by *Berg* in view of *Gerbaulet* has not been made. Thus, claim 17 is not obvious under proposed combination and the rejection should be withdrawn.

f. Claims 18-20

With respect to claims 18-20, because independent claim 17 is allowable over the cited art of record, dependent claims 18-20 (which depend from independent claim 17) are allowable as a matter of law for at least the reason that dependent claims 18-20 contain all features of independent claim 17 and the reference of *Smith* does not remedy all of the deficiencies of the *Berg* and *Gerbaulet* references. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, the rejection to these claims should be withdrawn.

Additionally and notwithstanding the foregoing reasons for allowability of claims 18-20, these claims recite further features and/or combinations of features (as is apparent by examination of the claims themselves) that are patentably distinct from the cited art of record. Hence, there are other reasons why these dependent claims are allowable.

For at least these reasons, the rejections should be withdrawn.


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CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,


Charles W. Griggers
Reg. No. 47,283

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